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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,964	01/29/2004	William A. Margiloff	E03.001/U	4330
28062	7590	02/23/2007	EXAMINER	
BUCKLEY, MASCHOFF, TALWALKAR LLC 50 LOCUST AVENUE NEW CANAAN, CT 06840			ORR, HENRY W	
			ART UNIT	PAPER NUMBER
			2176	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/23/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/766,964	MARGILOFF ET AL.	
	Examiner Henry Orr	Art Unit 2176	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 29 January 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 7-12, 19 and 20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 and 13-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 January 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All . b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/15/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

1. This action is responsive to application communication filed on 1/29/2004.
2. Claims 1-6 and 13-18 are pending in the case. Claims 1 and 13 are independent claims.
3. Claims 7-12, 19 and 20 are withdrawn from further consideration as being drawn to a non-elected invention.

***Election/Restrictions***

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6 and 13-18, drawn to Operator Interface/Menu or selectable iconic array, classified in class 715, subclass 810.
  - II. Claims 7-10 and 19, drawn to Data Processing: Financial, Business Practice, Management/Distribution or redemption of coupon, or incentive or promotion program classified in class 705, subclass 014.
  - III. Claims 11,12 and 20, drawn to Database/Query processing, classified in class 707, subclass 3.
5. Inventions I, II and III are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are considered independent from each other in design, operation,

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function or effect. Invention I as claimed is directed to facilitating use of a graphical user interface toolbar. Invention II as claimed is directed to presenting advertising information. Invention III as claimed is directed to facilitating searching via a graphical user interface. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Patrick Buckley on 2/16/2007 a provisional election was made without traverse to prosecute the invention of group I, claims 1-6 and 13-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-12, 19 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Priority***

8. Applicant's claim for the benefit of U.S. provisional applications, filed 1/29/2003 under 35 U.S.C. 119(e) is acknowledged.

***Information Disclosure Statement***

9. The information disclosure statement (IDS) submitted on 3/15/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

***Drawings***

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- a) Ref. #602 in Figure 6

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**12. Claims 1-6 and 13-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Sommer, U.S Publication Application #2004/0100504 A1 with a provisional filing date of May 24, 2002.**

Regarding claim 1, Sommer teaches “**an item selection system in which a first menu is positioned in a first menu space, a second menu space, a second menu is positioned in a second menu space, and when a cursor selects a particular item from the first menu, the second menu replaces the first menu”** (par. 7). (claim 1; i.e., providing to a user an initial set of toolbar buttons in a toolbar; receiving a single indication from the user; i.e., providing to the user a subsequent set of toolbar buttons in the toolbar at least in part in response to the received indication.)

Examiner interprets the items on the menu as equivalent to toolbar buttons in a toolbar because applicant admitted in the applicant’s specification that a “toolbar” refers to a graphical user interface having one or more buttons, icons, menus, and/or other user selectable features operable to send a command, trigger an event (Applicant

specification; p. 4 lines 14-18). Therefore, the items on the first menu graphical user interface represent the buttons that can trigger an event. Examiner also interprets when the cursor selects as a single indication from the user and the provided items on the second menu as a subsequent set of toolbar buttons.

Regarding claim 2, Sommer teaches “**When the cursor moves from the particular item to a further item within the first menu, the second menu changes**” (par. 9). (claim 2; i.e., providing to the user additional sets of toolbar buttons in the toolbar at least in part in response to additional received indications.) Examiner interprets the cursor moving within the first menu as additional received indications. The additional sets of toolbar buttons are provided when the second menu changes.

Regarding claim 3, Sommer’s Figure 2 illustrates that the initial set of items on the first menu are capable of being related to a common class of functionality (Figure 2, par. 28). (claim 3; i.e., wherein each toolbar button within the initial set of toolbar buttons is related to a common class of functionality.) Examiner interprets the items on the first menu shown on level 1 in Figure 2 to be capable of being related to a common class of functionality such as online purchasing or online browsing because the item selection system can be used in a hotel video on-demand system which provides a hotel guest with an user-friendly interface for selecting movies and other audio-visual products.

Regarding claim 4, Sommer’s **Figure 2 illustrates that the items on the second menu are capable of being related to a common class of functionality** (Figure 2, par. 32). (claim 4; i.e., wherein each toolbar button within the subsequent set of toolbar buttons is related to a common class of functionality.) Examiner interprets the

items on the second menu shown on level 2 in Figure 2 to be capable of being related to a common class of functionality such as movie browsing because each item may correspond to a type of movie (par. 34).

Regarding claim 5, Sommer teaches “**the second menu replaces the first menu**” (par. 7). (claim 5; i.e., wherein the subsequent set of toolbar buttons replaces the initial set of toolbar buttons within the toolbar.) Examiner interprets the second menu as the subsequent set of toolbar buttons and the first menu as the initial set of toolbar buttons because a menu graphical interface with items is considered a toolbar with buttons as explained in the rationale of claim 1.

Regarding claim 6, Sommer’s **Figure 1 illustrates an instruction space feature** <sup>WDT</sup> <sub>2/20/07</sub> **that is not replaced when the subsequent item buttons of the second menu replaces the initial item buttons on the first menu (Figure 1, par. 28).** (claim 6; i.e., wherein the toolbar includes at least one other toolbar feature in addition to the initial set of toolbar buttons, and the at least one other feature is not replaced by the subsequent set of toolbar buttons.) Examiner interprets the instruction space as a feature that remains after the first menu is replace by the second menu.

Claims 13, 14, 15, 16, 17 and 18 are apparatus claims and are substantially encompassed in method claims 1, 2, 3, 4, 5 and 6 respectively; therefore the apparatus claims are rejected under the same rationale as method claims 1, 2, 3, 4, 5 and 6 above. In respect to the processor and storage device of the apparatus claims, Sommer discloses the item selection system being displayed on computer screen which would inherently require a storage device and processor for executing the user-friendly

interface program to perform the limitations of claims 13, 14, 15, 16, 17 and 18 (par. 28).

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Orr whose telephone number is (571) 270 1308. The examiner can normally be reached on Monday thru Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

2/20/2007  
HO

  
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